

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Wong *et al.*

Serial No. 09/160,635

Filed: September 24, 1998

For: **IMPROVED FORMULATION
FOR CONTROLLED RELEASE
OF DRUGS BY COMBINING
HYDROPHILIC AND
HYDROPHOBIC AGENTS**

) Group No.: 1617

) Examiner: Webman, E.

) CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)(1)(i)(A)

) I hereby certify that this correspondence (along with any referred to as
being attached or enclosed) is, on the date shown below, being deposited
with the U.S. Postal Service with sufficient postage as first class mail in an
envelope addressed to: Assistant Commissioner for Patents, Washington,
D.C. 20231.

) Dated: 11/15/01 By: FERN S. MARDER

DECLARATION OF TODD A. LORENZ

I, Todd A. Lorenz, hereby declare and state as follows:

1. I am a partner with the firm of Flehr Hohbach Test Albritton & Herbert LLP, Four Embarcadero Center, Suite 3400, San Francisco, California 94111, and I am the working attorney assigned responsibility for the above-identified application.

2. The above-identified application was transmitted to the United States Patent and Trademark Office on September 24, 1998, as a continuation of U.S. Patent Application Serial No. 08/459,134, filed June 2, 1995.

3. A Final Office Action was mailed on April 10, 2001 in the case, requiring a response by July 10, 2001, extendable by three additional months. I contacted the Examiner by telephone on August 28, 2001, to discuss the fairness of an election requirement imposed in the final action, and to request the Examiner's consideration of an amended claim set. It was agreed during that telephone call that the Examiner would withdraw finality and reopen prosecution on the proposed amended claim set upon receipt.

4. Based upon this discussion I then mailed an Amendment and Response Under 37 C.F.R. § 1.116 on September 18, 2001, along with a Petition for a Three Month Extension of Time under 37 C.F.R. § 1.136, with the expectation that the finality of the Examiner's outstanding rejection would be promptly withdrawn and prosecution reopened based on the amended claim set.

JAN 04 2001

OFFICE OF PETITIONS
DEPUTY AC PATENTS

BEST AVAILABLE COPY


5. On October 11, 2001, one day after the case went abandoned, the Examiner mailed an Advisory Action in which he refused entry of the proposed amendments. I contacted the Examiner on October 19, 2001, immediately upon my receipt of the Advisory Action, to inquire about the status of the case and the Examiner's apparent change of heart. The Examiner indicated that he had forgotten about the agreement reached during the August 28th telephone call when issuing the Advisory Action, and as a courtesy he further indicated that he would attempt to reinstate the case, presumably pursuant to MPEP § 711.03(a).

6. Thereafter, in a follow-up telephone conference on November 2, 2001, the Examiner informed me that he had been unable to reinstate the case and suggested that Applicant submit an appropriate petition to revive. This time, the Examiner provided an Interview Summary confirming the substance of the agreement, *i.e.*, that the election of species requirement would be withdrawn and the amended claim set considered upon revival of the application.

7. At no time did Applicant or any of its attorneys indicate an intent to abandon the subject application. To the contrary, Applicant through its attorneys has diligently pursued the case and in fact has provided the Examiner with advance notice of its intentions with regard to the continued prosecution of the case. Moreover, Applicant's amendment and response mailed on September 18, 2001 was timely submitted based upon an informal agreement with the Examiner as to the continued prosecution of the case. There was clearly no expectation on the part of Applicant or its attorney that the amendment would be refused entry, let alone that the case would go abandoned based on a belated rejection of Applicant's proposed amendment. Accordingly, in view of these facts, there could not have been any intention to abandon the case.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001 and that willful, false statements may jeopardize the validity/enforceability of the application or any patent issued thereon.

11/14/01
Dated



Todd A. Lorenz